



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/540,187

02/13/2006

Christian Noe

WEB-43085

1190

24131 7590 01/12/2009
LERNER GREENBERG STEMER LLP
P O BOX 2480
HOLLYWOOD, FL 33022-2480

EXAMINER

CHUNG, SUSANNAH LEE

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

01/12/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/540,187	Applicant(s) NOE ET AL.	
	Examiner Susannah Chung	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-15, 18-21 and 24-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-15, 18-21, and 24-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 13-15, 18-21, and 24-32 are pending in the instant application. Claims 1-12, 16-17, and 22-23 are canceled.

Response to Non-Final Office Action

Acknowledgment is made of applicant's response and amendment of the claims filed on 9/23/2008.

Claim 13-32 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims were rejected as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. Applicants arguments and amendment to the claims have been considered, but are not persuasive. The steps are acknowledged, but the order is not clear. In claim 13, page 7 of 19, the steps need to be clarified. Where is the solvent being used. Is the solvent used during the recrystallization process or is the solvent used for precipitating out the product. Further clarification is required. Terms like "wherein" can be used before the phrase "a solvent" in line 7 to further clarify the claim language.

Claims 13-32 were rejected under 35 U.S.C. 102(b) as being anticipated by Noe, et al (U.S. Pat. No. 6,307,060 B1 ('060 Patent)). Applicants argue that the addition of the solvent specifically overcomes the '060 Patent. Examiner respectfully disagrees. Noe discloses the use of the solvents claimed in the instant application. For example, see '060 Patent, Example 1, Columns 10-11, in particular column 11, approximately lines 3-5, wherein 2-butanone is used in the workup.

Art Unit: 1626

Claims 13-32 were rejected under 35 U.S.C. 102(b) as being unpatentable over Noe, et al (U.S. Pat. No. 6,307,060 B1 ('060 Patent)). Applicants arguments have been considered, but are not found persuasive. (See previous office action and above discussion regarding the solvent.)

Claims 13-32 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 9, 10, and 15-18 of U.S. Patent Num. 6,307,060 ('060 Patent). Applicants arguments have been considered, but are not found persuasive. (See previous office action and above discussion regarding the solvent.)

In summary, claims 13-15, 18-21, and 24-32 are not patentable over the prior art. The issue is whether claims to a process of making a pure material is obvious over the prior art. It is asserted that that the instant process of purification is obvious to one of ordinary skill in the art when faced with the teachings of the '060 Patent. In addition, the utility of the purified compounds and the compounds disclosed in the prior art are the same. Applicants have not demonstrated that the process of purification or the purified compounds have a different or unexpected utility from the prior art compounds. Finally, the '060 Patent was directed to the purification of compounds. Purification in general is viewed as mere experimentation within the ability of one of ordinary skill in the chemical arts. Therefore, one of ordinary skill in the art would be able to utilize the teachings found in the '060 Patent to further purify the compounds as claimed in the instant application.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1626

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susannah Chung whose telephone number is (571) 272-6098. The examiner can normally be reached on M-F, 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/540,187

Page 5

Art Unit: 1626

Susannah Chung, 1/8/2009

/Golam M. M. Shameem/
Primary Examiner, Art Unit 1626